

Office Action Summary

Application No.

10/797,144

Applicant(s)

KANEKO ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2 and 7 is/are allowed.
- 6) ☒ Claim(s) 4, 5 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12-17-07; 11-29-07; 9-12-07
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 10-16-07
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 4, 5 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The identities of the "residue(s)" in claim 4 is unclear in that a residue may be construed as only a portion and it cannot be determined what portion of the compounds of claim 4 such residues encompass.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative obvious over Janssen et al. (EP 0856542, cited by applicants).

Patentees disclose a star shaped polymer having polyolefin arms coupled via an agent having ester and amine functionality having less than 200 atoms. See for instance the reaction shown at the top of pages 16 or 20. The term "derived from" is a process limitation and as such applicants claim 4 is in product by process form. Note page 13 for use of ester linking group such as would result in an acyl residue in the portion of the

linking group present in the polymer product as would also result from reaction of an anhydride rather than ester functionality.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Claims 4, 5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by either JP 58-217505 or JP 07-316225.

It is noted that the search report submitted by applicants (apparently submitted as applicants' concise explanation required for foreign language references) indicate that these patents disclose terminally unsaturated polyolefins coupled using silanes having two or three Si-H bonds (and thus may be trifunctional) and as applicants halogenated silanes would contain only silicon after displacement of halide, applicants' residue would be present in these materials.

Applicant's arguments filed 12-17-07 have been fully considered but they are not persuasive.

The instant claims merely recite that X superscript 3 is a "residue", a term which can include any portion of the linking group of Janssen and furthermore applicants residues are portions of the "compound(s)" recited by claim 4 and for this reason would include Janssens polymers in that the aromatic moiety shown in the center of the structure at the top of page 16 (a C₆H₃ triradical) would read on hexahydroxybenzene with the hydroxyl radicals removed. Unpatented claims are given their broadest reasonable interpretation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Mullis whose telephone number is 571 272 1075. The examiner can normally be reached on Mon-Friday from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seidleck James, can be reached on M-F. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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JCM

3-15-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796